



Attorney Docket # 3401-125RCE

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Mark FREIER et al.

Serial No.: 10/002,523

Filed: November 2, 2001

For: Endoscopic Sample Taker for Cartilage Material

Examiner: Thaler, Michael H.  
Group Art: 3731

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Alfred W. Froebrich  
Name of applicant, assignee or Registered Representative

Signature

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**APPEAL BRIEF**

SIR:

This is an appeal, pursuant to 37 C.F.R. § 41.37 from the decision of the Examiner in the above-identified application, as set forth in the Final Office Action wherein the Examiner finally rejected appellant's claims. The rejected claims are reproduced in the Appendix A attached hereto. A Notice of Appeal was filed on October 16, 2006 with a Pre-Appeal Brief Request for Review. A Notice of Panel Decision from Pre-Appeal Brief Review mailed February 27, 2007 states that the application remains under appeal because there is at least one issue for appeal.

The fee of \$500.00 for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20 is submitted herewith. Any additional fees or charges in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

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#### **REAL PARTY IN INTEREST**

The assignee, Richard Wolf GmbH, of applicants, Mark Freier, Eberhard Körner, and Helmut Hecke, is the real party of interest in the above-identified U.S. Patent Application.

#### **RELATED APPEALS AND INTERFERENCES**

There are no other appeals and/or interferences related to the above-identified application at the present time.

#### **STATUS OF CLAIMS**

Claims 1-7 and 9 have been cancelled. Claims 8 and 10-19 have been rejected. Claims 8 and 10-19 are on appeal.

#### **STATUS OF AMENDMENTS**

There have been no Amendments filed subsequent to the Final Office Action.

#### **SUMMARY OF THE CLAIMED SUBJECT MATTER**

Appellants' invention is directed to an endoscopic sample taker for collecting a sample of cartilage material and includes "a hollow shank (1) having a distal end and a proximal end" and "a scoop (2) fixedly connected to said distal end of said hollow shank and defining a spoon-shaped trough (5) having an opening and a closed end" (support for the spoon-shaped trough is found at page 5, line 2, and in Figs. 2-3 of the specification as filed). Independent claim 8 further recites "a handling means (3) connected at said proximal end of said hollow shaft and having an actuation mechanism (4)" and "an actuating rod (6) having a distal end and a

proximal end axially movable in said hollow shank, said proximal end of said actuating rod releasably connectable with said actuation mechanism” (the releasable connection is on page 6, lines 24-32 of the specification as filed). Independent claim 8 further recites “a covering (7) comprising a tongue having a longitudinal length with a first end fastened proximate said distal end of said actuating rod and a second distal end, said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue in response to axial adjustment of said actuating rod to an adjusted position between a closure position and an open position” (the covering is described on page 5, lines 6-15), wherein said open position of said tongue allows ingress of the cartilage material to said trough and said closure position covers said trough to prevent loss of the cartilage material from said trough, said adjusted position being maintained without external force on said actuating rod (see page 5, lines 29-31 of the original specification).

Independent claim 17 recites an endoscopic sample taker including “a hollow shank (1) having a distal end and a proximal end” and “a scoop (2) fixedly connected to said distal end of said hollow shank and defining a spoon-shaped trough (5) having an opening and a closed end” (support for the spoon-shaped trough is found at page 5, line 2, and in Figs. 2-3 of the specification as filed). Independent claim 17 further recites “a handling means (3) connected at said proximal end of said hollow shaft and having an actuation mechanism (4)” and an actuating rod (6) having a distal end and a proximal end axially movable in said hollow shank, said proximal end of said actuating rod releasably connectable with said actuation mechanism” (the releasable connection is on page 6, lines 24-32 of the specification as filed). Independent claim 8 further recites “a covering (7) comprising a tongue having a longitudinal length with a first end fastened proximate said distal end of said actuating rod and a second distal end, a position of said tongue being adjustable along a

longitudinal length of said tongue via said actuating rod to an adjusted position between a closure position and an open position” (the covering is described on page 5, lines 6-15), “wherein said open position of said tongue allows ingress of the cartilage material to said trough and said closure position covers said trough to prevent loss of the cartilage material from said trough, said adjusted position being maintained without external force on said actuating rod” (see page 5, lines 29-31 of the original specification).

Independent claim 17 further recites “wherein said tongue comprises a thin strip” (see page 5, lines 8-12) “having a longitudinal length, wherein the position of said covering is adjustable by axially displacing the thin strip along the longitudinal length of the thin strip so that the strip moves across the opening defined by said spoon-shaped trough in response to said actuating rod” (see Fig. 2; page 5, lines 19-22).

## **GROUND OF REJECTION TO BE REVIEWED IN APPEAL**

1. Whether claims 8 and 10-19 are patentable under 35 U.S.C. §103 over U.S. Patent No. 4,953,559 (Salerno) in view of U.S. Patent No. 4,569,131 (Falk)?

### **ARGUMENT**

#### **Independent Claim 8**

Independent claim 8 recites “said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue in response to axial adjustment of said actuating rod to an adjusted position between a closure position and an open position”.

The Examiner alleges that the combination of appendage 4, lever 5, and body 12 of Salerno comprises the recited “tongue” and that the parts 4, 5, 12 in Salerno “slide along a longitudinal length of the tongue”, as recited in independent claim 8. In contrast, the parts 4, 5,

and 12 of Salerno pivot about a transverse axis instead of sliding along a longitudinal length. More specifically, the appendage 4 and lever 5 are articulated about a transverse axis 8 (see col. 2, lines 57-62, of Salerno). The body 12 is an insulating material arranged between the lever 5 and the sides of the transverse notch 7 in the body 1 (col. 3, lines 6-13). Even if the movement of the portion 12 with lever 5 is considered to slide relative to the notch 7 of the body 1, this movement can not be considered to be “along a longitudinal length”, as recited in independent claim 8.

The Examiner recites a definition of the term “along” as “at a point or points on” (as in a house *along* a river). While that is indeed one of the definitions, the dictionary also includes another definition of “along” as “in a line matching the length or direction of”. The latter definition is the only appropriate one of the definitions given the context of the term “along” in claim 8, i.e., “slides along a longitudinal length of said tongue”. Even if the Examiner's definition of “along” is used, the combination 4, 5, 12 of Salerno can not be considered to slide along a longitudinal length of the tongue. Rather, the combination 4, 5, 12 of Salerno slides relative to the body 1 at points along a circumference relative to the transverse axis 8.

Falk fails to teach or suggest what Salerno lacks. Falk discloses a tool with an interchangeable insert portion with a pincher-like tool 12 arranged at a distal end thereof (see Fig. 3a of Falk). The pincher includes members 13, 14 which are pivotally connected for relative movement from an open to a closed position (see col. 3, lines 33-39 of Falk). The pivoting of member 14 of Falk fails to disclose a tongue that “slides along a longitudinal length of the tongue”, as recited in independent claim 8.

Accordingly, independent claim 8 is allowable over Salerno in view of Falk.

### Independent Claim 17

Independent claim 17 recites "wherein said tongue comprises a thin strip having a longitudinal length, wherein the position of said covering is adjustable by axially displacing the thin strip along the longitudinal length of the thin strip so that the strip moves across the opening defined by said spoon-shaped trough in response to said actuating rod".

The appendage 4 of Salerno can not be considered to be a thin strip having a longitudinal length, as recited in independent claim 17. In contrast, the appendage 4 is cup- or bowl-shaped. The jaws 13, 14 of Falk likewise can not be considered to be a thin strip.

Furthermore, the pivoting or rotational movement of the jaws of Salerno and Falk fail to disclose, teach or suggest (1) axially displacing the thin strip along the longitudinal length of the thin strip, and (2) that the strip moves across the opening defined by said spoon-shaped trough. Regarding the first reason, the appendage 4 of Salerno is arranged at the end of a lever 5, which is articulated about a transverse axis 8 (see col. 2, lines 57-62, of Salerno). When the lever is pivoted, the appendage 4 is circumferentially displaced and not axially displaced along a longitudinal axis of the cover. The pivoting of the appendage in Salerno (and the jaw of Falk) is an entirely different movement from the axial displacement of the cover recited in independent claim 8. Even though the overall movement of the tip of the appendage 4 has a component in the axial direction relative to the rod of the medical device on which the appendage 4 is mounted, the circumferential movement of the appendage 4 cannot be considered to be an axial displacement "along the longitudinal length of the cover", as recited in independent claim 17.

Furthermore, the pivoting action of the lever does not move the appendage 4 across the opening of the trough in Salerno. Rather, the appendage 4 is moved onto the other

appendage 2. Accordingly, the pivotal movement of the appendage 4 of Salerno cannot be considered to be moving across the opening defined by the trough.

In view of the above amendments and remarks, independent claim 17 is also deemed to be allowable over Salerno in view of Falk.

#### Dependent Claims

Dependent claims 10-16 and 18-19, each being dependent on one of independent claims 8 and 17, are allowable for at least the same reasons as are independent claims 8 and 17, as well as for the additional recitations contained therein.

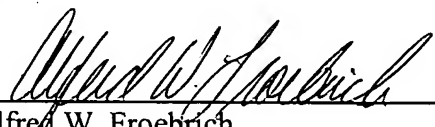
For the foregoing reasons, it is respectfully submitted that the combined teachings of Salerno and Falk fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claims 8 and 10-19. The Final Rejection of the claims 8 and 10-19 should be reversed.

#### CONCLUSION

For the foregoing reasons, it is respectfully submitted that appellants' claims are not rendered obvious by and are, therefore, patentable over the art of record, and the Examiner's rejections should be reversed.

Respectfully submitted,  
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By

  
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## CLAIMS APPENDIX

1.-7. (canceled)

8. (previously presented) An endoscopic sample taker for collecting a sample of cartilage material, comprising:

a hollow shank having a distal end and a proximal end;

a scoop fixedly connected to said distal end of said hollow shank and defining a spoon-shaped trough having an opening and a closed end;

a handling means connected at said proximal end of said hollow shaft and having an actuation mechanism;

an actuating rod having a distal end and a proximal end axially movable in said hollow shank, said proximal end of said actuating rod releasably connectable with said actuation mechanism; and

a covering comprising a tongue having a longitudinal length with a first end fastened proximate said distal end of said actuating rod and a second distal end, said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue in response to axial adjustment of said actuating rod to an adjusted position between a closure position and an open position, wherein said open position of said tongue allows ingress of the cartilage material to said trough and said closure position covers said trough to prevent loss of the cartilage material from said trough, said adjusted position being maintained without external force on said actuating rod.

9. (canceled)

10. (previously presented) The endoscopic sample taker of claim 8, wherein said trough comprises an edge defining a shape of said opening of said trough, said tongue sufficiently covering said trough in said closed position so that an entire sample within the volume defined between said opening and said closed end is prevented from leaving said trough.



11. (previously presented) The endoscopic sample taker of claim 8, further comprising a holding-down device for guiding said tongue during the displacement thereof along the longitudinal length of said tongue and holding said tongue at said closure position.

12. (previously presented) The endoscopic sample taker of claim 8, wherein said scoop comprises an edge forming said trough and said edge is inclined at an angle relative to a longitudinal axis of said hollow shank such that a retrograde inclination is exhibited by said edge of said scoop.

13. (previously presented) The endoscopic sample taker of claim 12, wherein said tongue is made of a bendable elastic material.

14. (previously presented) The endoscopic sample taker of claim 8, wherein said tongue comprises a front cutting edge for facilitating separation of the sample of cartilage material.

15. (previously presented) The endoscopic sample taker of claim 8, wherein a volume defined between said opening and said closed end of said trough of said scoop is separated from a volume defined by said hollow shank such that the volume defined by said trough is not in direct communication with the volume defined by said hollow shank.

16. (previously presented) The endoscopic sample taker of claim 8, wherein an entire volume defined between said opening and said closed end of said trough of said scoop is arranged distally from said distal end of said hollow shank by an axial distance.

17. (previously presented) An endoscopic sample taker, comprising:  
a hollow shank having a distal end and a proximal end;  
a scoop fixedly connected to said distal end of said hollow shank and defining a spoon-shaped trough having an opening and a closed end;  
a handling means connected at said proximal end of said hollow shaft and having an actuation mechanism;

an actuating rod having a distal end and a proximal end axially movable in said hollow shank, said proximal end of said actuating rod releasably connectable with said actuation mechanism; and

a covering comprising a tongue having a longitudinal length with a first end fastened proximate said distal end of said actuating rod and a second distal end, a position of said tongue being adjustable along a longitudinal length of said tongue via said actuating rod to an adjusted position between a closure position and an open position, wherein said open position of said tongue allows ingress of the cartilage material to said trough and said closure position covers said trough to prevent loss of the cartilage material from said trough, said adjusted position being maintained without external force on said actuating rod, wherein said tongue comprises a thin strip having a longitudinal length, wherein the position of said covering is adjustable by axially displacing the thin strip along the longitudinal length of the thin strip so that the strip moves across the opening defined by said spoon-shaped trough in response to said actuating rod.

18. (previously presented) The endoscopic sample taker of claim 17, further comprising a holding-down device for guiding said thin strip during the displacement thereof and holding said tongue at said closure position.

19. (previously presented) The endoscopic sample taken of claims 8, wherein said actuating mechanism comprises a sleeve connected to said handling means, an external ring axially displaceably arranged outside said sleeve, an inner ring arranged inside said sleeve, and a fastening bar passing through said inner and external rings, said actuating rod being actuatable by axial movement of said outer ring.

EVIDENCE APPENDIX

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RELATED PROCEEDINGS APPENDIX

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